

REMARKS

Claims 1-11, 13-15, 17-25 and 40 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-4, 7-11, 14, 15, 17-19, 21, 22, 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Creavey (U.S. Pat. No. 3,033,582, hereinafter "Creavey") in view of Udagawa (U.S. Pat. No. 6,186,513, hereinafter "Udagawa"). This rejection is respectfully traversed.

Claims 17 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jackson (U.S. Pat. No. 2,513,178, hereinafter "Jackson") in view of Udagawa. This rejection is respectfully traversed.

Claims 5, 16, 13, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Creavey in view of Udagawa, as applied to claims 1, 10, and 17 above, and further in view of Combet et al. (U.S. Pat. No. 6,390,479, hereinafter "Combet"). This rejection is respectfully traversed.

Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Creavey in view of Udagawa, as applied to claim 17 above, and further in view of Lucas et al. (U.S. Pat. No. 4,635,949, hereinafter "Lucas"). This rejection is respectfully traversed.

In response to Applicant's hindsight argument, the Examiner indicates that "[o]ne of ordinary skill, looking at the prior art reference of Udagawa would recognize that

stoppers [may] be formed either way to arrive at the same result.” However, Applicants submit that in order to arrive at this result, one would also need to look at the claimed gasket. This is the essence of an impermissible hindsight reconstruction. There is nothing present in the references to motivate or suggest their combination or the modifications required by the Examiner. Therefore, the Examiner’s rejection appears to be nothing more than a hindsight reconstruction of Applicant’s claimed gasket resulting from picking and choosing individual elements from each of the references.

Specifically, Udagawa discloses an entirely metal gasket, including the seal member (E13, F13 in Figs. 6 and 7). Any portion of Udagawa that could be considered the stopper member (E12, F12) is integrally formed with a “top surface” of a carrier portion of the gasket (F10). The same is true in both Ceavey and Jackson. Each of claims 1, 10, and 17 requires a generally flat carrier member with a generally planar surface, stopper members independently formed from the carrier and located on the top surface, and an elastomeric seal member on the top surface.

Contrary to the claimed features, Udagawa discloses a carrier having a non-planar surface and a metal, not elastomeric, seal member. Further, Udagawa merely discloses two metal plates F10, F15 in Figure 7 placed on top of one another, not the claimed carrier having independently formed stopper members and an elastomeric seal member extending from a top surface thereof. In order to arrive at his gasket constructed from the combination of references, he must selectively pick and choose among the various elements. Specifically, he must ignore the integrally formed stopper members in Ceavey and Jackson. He must then take the metal gasket (F10) of Udagawa having integrally formed carrier, sealing, and stopper portions and take only

the stopper portion. As indicated above, it appears that the only way one skilled in the art could arrive at the gasket constructed by the Examiner is by first viewing the features of the claimed gasket. As such, Applicants again submit that this is an improper hindsight reconstruction and, therefore, claims 1, 10, and 17 are in condition for allowance.

Additionally, Applicants note that claim 1 recites the “first and second stopper members forming a cavity therebetween, with each having a height above said top surface” and “an elastomeric seal member located in said cavity ... having an apex which extends from said top surface and is greater than said height of said first and second stopper members.” The apex portion (30) in Creavey cannot be seen as extending from the top surface, as it extends from portion (13) which extends above stopper member (16), as seen in Figure 3. Applicants note that Figures 4 and 5 merely show the gasket of Figure 3 under fluid pressure and therefore cannot be seen as teaching the limitations of claim 1 either. As such, Applicants submit that these features place claim 1 in condition for allowance in addition to those set forth above.

Claims 2-9, 11, 13, 15, 18-25 and 40 depend from claims 1, 10, and 17, and should be in condition for allowance for the reasons set forth above. Therefore, reconsideration and withdrawal of the rejection of claims 1-11, 13, 15, 17-25 and 40 are respectfully requested.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests

that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: 9-29-06

By: Ryan W. Massey
Ryan W. Massey, Reg. No. 38,543

HARNES, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600

CORRESPONDENCE ADDRESS:

CUSTOMER NO. 29293

Freudenberg-NOK General Partnership
Legal Department
47690 East Anchor Court
Plymouth, MI 48170-2455
Ph: (734) 354-5445
Fax: (734) 451-1445